

FORM PTO-1390 (Modified)  
(REV 10/95)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NUMBER

TRANSMITTAL LETTER TO THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)  
CONCERNING A FILING UNDER 35 U.S.C. 371

196838US0PCT

U.S. APPLICATION NO. (IF KNOWN, SEE 37 CFR

09/623872

INTERNATIONAL APPLICATION NO.  
PCT/US99/05131INTERNATIONAL FILING DATE  
09 March 1999PRIORITY DATE CLAIMED  
10 March 1998 (earliest)

## TITLE OF INVENTION

NOVEL OPIATE COMPOUNDS, METHODS OF MAKING AND METHODS OF USE

APPLICANT(S) FOR DO/EO/US

Frank I. CARROLL, et al.

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. ☒ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. ☒ A copy of the International Application as filed (35 U.S.C. 371 (c) (2))
  - a. ☐ is transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☐ has been transmitted by the International Bureau.
  - c. ☒ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7. ☒ A copy of the International Search Report (PCT/ISA/210).
8. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
  - a. ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☐ have been transmitted by the International Bureau.
  - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
  - d. ☒ have not been made and will not be made.
9. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
10. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
11. ☒ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).

## Items 13 to 18 below concern document(s) or information included:

13. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15. ☐ A **FIRST** preliminary amendment.  
A **SECOND** or **SUBSEQUENT** preliminary amendment.
16. ☐ A substitute specification.
17. ☐ A change of power of attorney and/or address letter.
18. ☐ Certificate of Mailing by Express Mail
19. ☒ Other items or information:

Request for Consideration of Documents Cited in International Search Report  
Notice of Priority  
PCT/IB/304

U.S. APPLICATION NO. (IF KNOWN, SEE 09/623872)		INTERNATIONAL APPLICATION NO. PCT/US99/05131		ATTORNEY'S DOCKET NUMBER 196838US0PCT	
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20. The following fees are submitted:

**BASIC NATIONAL FEE ( 37 CFR 1.492 (a) (1) - (5) ) :**

☐ Search Report has been prepared by the EPO or JPO ..... \$840.00

☒ International preliminary examination fee paid to USPTO (37 CFR 1.482) ..... \$670.00

☐ No international preliminary examination fee paid to USPTO (37 CFR 1.482) but international search fee paid to USPTO (37 CFR 1.445(a)(2)) ..... \$760.00

☐ Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO ..... \$970.00

☐ International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(2)-(4) ..... \$96.00

**ENTER APPROPRIATE BASIC FEE AMOUNT =**

Surcharge of \$130.00 for furnishing the oath or declaration later than ☐ 20 ☒ 30 months from the earliest claimed priority date (37 CFR 1.492 (e)).

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE	TOTAL	
Total claims	26 - 20 =	6	x \$18.00	\$108.00	
Independent claims	4 - 3 =	1	x \$78.00	\$78.00	
Multiple Dependent Claims (check if applicable). <input type="checkbox"/>				\$0.00	
<b>TOTAL OF ABOVE CALCULATIONS</b>				<b>\$986.00</b>	
Reduction of 1/2 for filing by small entity, if applicable. Verified Small Entity Statement must also be filed (Note 37 CFR 1.9, 1.27, 1.28) (check if applicable). <input type="checkbox"/>				\$0.00	
<b>SUBTOTAL</b>				<b>\$986.00</b>	
Processing fee of \$130.00 for furnishing the English translation later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 months from the earliest claimed priority date (37 CFR 1.492 (f)).				\$0.00	
<b>TOTAL NATIONAL FEE</b>				<b>\$986.00</b>	
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31) (check if applicable). <input type="checkbox"/>				\$0.00	
<b>TOTAL FEES ENCLOSED</b>				<b>\$986.00</b>	
				Amount to be: refunded	\$
				charged	\$

☒ A check in the amount of \$986.00 to cover the above fees is enclosed.


☐ Please charge my Deposit Account No. \_\_\_\_\_ in the amount of \_\_\_\_\_ to cover the above fees.  
A duplicate copy of this sheet is enclosed.

☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. \_\_\_\_\_ A duplicate copy of this sheet is enclosed.

**NOTE:** Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:

NEUSTADT, P.C.



22850

Surinder Sachar  
Registration No. 34,423

\_\_\_\_\_  
SIGNATURE

Norman F. Oblon  
NAME

24,618  
REGISTRATION NUMBER

\_\_\_\_\_  
DATE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Frank I. CARROLL, et al.

SERIAL NUMBER: NEW U.S. PCT APPLICATION (based on PCT/US99/05131)

FILED: HEREWITH

FOR: NOVEL OPIATE COMPOUNDS, METHODS OF MAKING AND METHODS OF USE

**REQUEST FOR CONSIDERATION OF DOCUMENTS  
CITED IN INTERNATIONAL SEARCH REPORT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

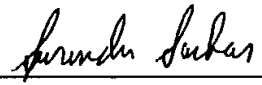
In the matter of the above-identified application for patent, notice is hereby given that applicant(s) request that the Examiner consider the documents cited in the International Search Report according to MPEP §609 and so indicate by a statement in the first Office Action that the information has been considered. When the Form PCT/DO/EO/903 indicates both the search report and copies of the documents are present in the national stage file, there is no requirement for the applicant(s) to submit them (1156 O.G. 91 November 23, 1993).

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



**22850**

  
Norman F. Oblon  
Attorney of Record  
Registration No. 24,618  
Surinder Sachar  
Attorney of Record  
Registration No. 34,423

DOCKET NO.: 196838US0PCT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Frank I. CARROLL, et al.

SERIAL NO.: NEW U.S. PCT APPLICATION

FILED: HEREWITH

INTERNATIONAL APPLICATION NO.: PCT/US99/05131

INTERNATIONAL FILING DATE: 09 March 1999

FOR: NOVEL OPIATE COMPOUNDS, METHODS OF MAKING AND METHODS OF  
USE**REQUEST FOR PRIORITY UNDER 35 U.S.C. 119(e)  
AND THE INTERNATIONAL CONVENTION**Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

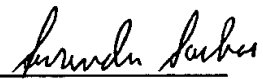
In the matter of the above-identified application for patent, notice is hereby given that the applicant claims as priority:

<b><u>COUNTRY</u></b>	<b><u>APPLICATION NO</u></b>	<b><u>DAY/MONTH/YEAR</u></b>
UNITED STATES	60/077,402	10 March 1998
UNITED STATES	60/107,902	10 November 1998

Certified copies of the corresponding Convention application(s) were submitted to the International Bureau in PCT Application No. **PCT/US99/05131**. Receipt of the certified copy(s) by the International Bureau in a timely manner under PCT Rule 17.1(a) has been acknowledged as evidenced by the attached PCT/IB/304.

Respectfully submitted,  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

**22850**

  
Norman F. Oblon  
Attorney of Record  
Registration No. 24,618  
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